

REMARKS

Applicants respectfully request reconsideration of the instant application in view of the foregoing amendments and the following remarks. Claims 31, 38-41, 55, 61, 65-68, and 115 are pending. Claims 1-30, 32-37, 42-54, 56-60, 62-64 and 69-114 have been previously cancelled. Claims 31, 55, and 115 are the only independent claims. Claims 31, 55, and 115 have been amended. No new matter has been added by these amendments.

Rejection Under 35 USC § 101

Claims 31, 38-41, 55, 61, 65-68, and 115 are rejected under 35 U.S.C. § 101 as allegedly been directed to nonstatutory subject matter. More specifically, it is alleged in the Office Action that in order for a method to be considered a "process" under § 101, a claimed process must either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials). Applicants respectfully traverse the § 101 rejection and submit that the pending claims are directed to statutory subject matter in accordance with 35 USC § 101.

The Examiner, on page 2 of the Office Action, asserts that the "language of a "processor enabled method" is not a recitation that the entire method is being executed by a processor, this just recites that the method could be done by a processor." (August 19, 2008 Office Action, p. 2, § 3). Applicants respectfully disagree as the method itself is a "processor-enabled method." However, independent claims 31, 55, and 115 have been amended to recite "calculating **by a processor** a customer-specific, fixed, guaranteed program price..." Emphasis added. As independent claims 31, 55, and 115 recite elements including a processor, Applicants submit that the elements of the claim are 'tied to another statutory class.' Accordingly, for at

least these reasons, Applicants submit that independent claims 31, 55, and 115, as well as the claims directly or indirectly dependent therefrom, are directed to statutory subject matter and withdrawal of this ground of rejections is requested.

Rejection Under 35 USC § 112, first paragraph

Claim 115 has been rejected under 35 U.S.C. § 112, first paragraph as allegedly failing to comply with the written description requirement. Specifically, the Examiner asserts, on page 3 of the Office Action, that the "specification as originally filed does not disclose anything about 'incident to the establishment of an affinity relationship between the program sponsor and the customer.'" (August 19, 2008 Office Action, p. 3, § 5). Applicants respectfully traverse this rejection and submit that support for the amended claim language may be found in the originally filed specification, drawings and claims.

By way of non-limiting example only, Applicant directs the Examiner's attention to p.14 lines 14-18 of the specification that states that "the buyer is required to establish a co-branded or affinity or other relationship with a program sponsor." Furthermore, to clarify the scope of claim 115, the term "incident" has been deleted from the claim. Accordingly, Applicants submit that claim 115 is in condition of immediate allowance for at least the foregoing reasons.

Rejection Under 35 USC § 112, second paragraph

Claims 31, 38-41, 55, 61, 65-68, and 115 are rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Specifically, the Examiner has alleged that "[f]or claims 31, 55, 115 the language 'for a for a type of vehicle fuel that a customer is authorized to pay for any qualified fuel purchase from any qualified fuel vendor' is indefinite." (August 19, 2008 Office Action, p. 4, § 7). Applicants have amended claims 31, 55, and 115 to correct informalities and provide clarification. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejections.

Rejection Under 35 USC § 103

Claims 31, 38-41, 55, 61, 65-68, and 115 have been rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over McCall et al. US Patent No. 6,321,984 (hereafter "McCall"), in view of Infinity Trading Group, from January 9, 1998, infinitytrading.com (hereafter "Infinity") and further in view of "Weather futures bet will give Tucson firms a hedge against loss," Arizona Daily Star, Tucson, Arizona, 5 February 1999 (hereafter "Weather Futures"). Applicants respectfully traverse the Examiner's rejections and submit that a *prima facie* case of obviousness has not been established and that the pending claims are patentably distinct from the cited references, taken alone or in combination, for at least the following reasons.

I. Applicants submit that a prima facie case of obviousness has not been established

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and

- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicants submit that the rejections in the pending Office Action do not establish each of these requirements.

Applicants submit that the rejections in the August 19, 2008 Office Action do not address every claim limitation to establish the differences in the claim over the applied references and over-generalizes cited references. The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," [§ 2106 II(C), emphasis added] and, "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." [§ 2143.03, emphasis added]. The Examiner has failed to comply with this.

Independent Claim 31

For example, on page 5 of the Office Action dated August 19, 2008, the Examiner asserts "[f]or claims 31, 55, 61, 115 McCall discloses a system and method for selling vehicle fuel to customers." No limitations are discussed for any of the claims mentioned. On page 6 of the Office Action, the Examiner attempts to address claim 31 but paraphrases what is actually claimed to "the claimed receiving of program sponsor data that includes an amount of a finder's fee paid by a program sponsor." Applicants respectfully request that the Examiner's rejection adhere to the language recited in the claims. Otherwise, Applicants cannot be sure if, which, and/or to what claim limitations the rejection is addressing or asserting equivalents towards. The Applicants further request the Examiner to substantively address all recited claim elements because in the pending rejection only one limitation of claim 31 is addressed by paraphrasing.

Because every limitation of claim 31 is not addressed in the pending rejection, the differences in the claim over the applied references can not have been established therefore, a prima facie case of obviousness has not been established under 35 U.S.C. § 103. Applicants assert that the claimed elements are absent in the cited references and the Examiner has failed to show and/or particularly point out (as required) all elements of the claims. Accordingly, for at least these reasons, Applicants submit that independent claim 31 as well as the claims directly or indirectly dependent therefrom, are allowable.

Independent Claim 55

Firstly, Applicants submit that the Office Action has failed to consider every limitation of independent claim 55 as required by MPEP § 2106 II(C). On page 12 of the Office Action, dated August 19, 2008, the only paragraph addressing claim 55 states that "[f]or claim 55, in addition to that immediately above, the step of 'determining a market indicator relevant to the future price' is what you do when you are developing a financial hedging strategy involving the sale of fuel. You are inherently looking to market indicators that are relevant to the future price for the fuel." No further discussion of claim 55 is found in the Office Action therefore, all the elements are not addressed and a prima facie case of obviousness has not been established under 35 U.S.C. § 103.

Secondly, Applicants submit that the pending rejection has impermissibly grouped together pluralities of claims in common rejections that are not equally applicable to all claims in the groups. MPEP § 707.07 (d) prescribes that, "[a] plurality of claims should never be grouped together in a common rejection, unless that rejection is equally applicable to all claims in the group." (Emphasis added). By way of example only, Applicants note that the pending rejection has grouped together claims 55 and 115 in a common rejection as quoted above.

(August 19, 2008 Office Action, pp. 12). However, the rejection is clearly not "equally applicable to all claims in the group." Claim 55 and 115 do not have identical limitations therefore rejections for claim 55 can not be grouped with the rejections of claim 115.

Furthermore, the pending rejection has repeatedly grouped claims in this impermissible manner, and Applicants are confused as to which claims and claim elements the Examiner has applied citations and/or arguments in the pending office action. MPEP § 706 recites that, "[t]he goal of examination is to clearly articulate any rejection early in the prosecution process so that the applicant has the opportunity to provide evidence of patentability and otherwise reply completely at the earliest opportunity." Applicants submit that, by impermissibly grouping claims under a common rejection that is not equally applicable to all claims in the group, the pending rejection has not clearly articulated the rejection. Accordingly, Applicants respectfully request that, should the Examiner maintain the rejection, that he address each claim individually, with specific correspondence shown between claim elements and aspects of the cited references.

Because every limitation of claim 55 is not addressed in the pending rejection, the differences in the claim over the applied references can not have been established, therefore, a prima facie case of obviousness has not been established under 35 U.S.C. § 103. Applicants assert that the claimed elements are absent in the cited references and the Examiner has failed to show and/or particularly point out (as required) all elements of the claims. Accordingly, for at least these reasons, Applicants submit that independent claim 55 as well as the claims directly or indirectly dependent therefrom, are allowable.

Independent Claim 115

Under the 35 U.S.C. § 103 rejection in the Office Action, dated August 19, 2008, the limitation "incident to the on establishment of an affinity relationship between the program sponsor and the customer" is said allegedly to be directed to "non-functional descriptive material." Applicants respectfully disagree. However, to clarify claim 115 has been amended to recite a "program sponsor data includes an amount of a finder's fee paid by a program sponsor to a program operator on establishment of an affinity relationship between the program sponsor and the customer." It is clear that claim 115 is not directed to "non functional descriptive material" and the Examiner is requested to address this limitation.

The Office Action admits, by paraphrasing claim 115, that McCall does not disclose all the limitations of claim 115 and cites Infinity to cure the deficiencies. (August 19, 2008 Office Action, p. 7. However, the pending rejections are based on over-generalized applications of the cited references and summarized analysis. For example, the Office Action states, "having and receiving 'customer expected usage date' that includes a quantity of fuel to be purchased over a given number of months," (August 19, 2008 Office Action, p. 7) when in fact claim 115 recites, among other limitations, "receiving customer expected fuel usage data" and:

using customer expected fuel usage data, a projected retail fuel price and said finder's fee amount of said program sponsor data, wherein said customer expected fuel usage data includes: an anticipated primary geographic fuel usage area, a customer-specific quantity of fuel to be purchased, and a number of months during which the customer is authorized to buy fuel at the customer-specific, fixed, guaranteed program price for the type of fuel to be purchased

Applicants respectfully request that the Examiner's rejection adhere to the language actually recited in the claims and substantively address all recited elements of claim

115. Otherwise, Applicants cannot be sure if, which, and/or to what claim limitations the rejection is addressing or asserting equivalents towards.

Further, Applicants note that the pending rejection has cited no reference to the claim limitation "an anticipated primary geographic fuel usage area, a customer-specific quantity of fuel to be purchased, and a number of months during which the customer is authorized to buy fuel at the customer-specific, fixed, guaranteed program price for the type of fuel to be purchased". The rejection alleges an equivalence between the discount incentives discussed in McCall and the program price limitation of the pending claims. However, Applicants submit that none of cited references, or even the pending rejection itself discusses "a guaranteed program price" or "an anticipated primary geographic fuel usage area for fuel" or "a number of months during which the customer is authorized to buy fuel at the customer-specific, fixed, guaranteed program price for the type of fuel to be purchased" as recited in the claim 115. Accordingly, Applicants submit that the pending rejection fails to consider "all words in [the] claim," as required, for example, by MPEP § 2143.03.

Because every limitation of claim 115 is not addressed in the pending rejection, the differences in the claim over the applied references can not have been established, therefore, a prima facie case of obviousness has not been established under 35 U.S.C. § 103. Applicants assert that the claimed elements are absent in the cited references and the Examiner has failed to show and/or particularly point out (as required) all elements of the claims. Accordingly, for at least these reasons, Applicants submit that independent claim 115 is allowable.

Furthermore, Applicants submit that the rejection in the August 19, 2008, Office Action has not established why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made by not treating the claims as wholes

and by applying impermissible hindsight. MPEP § 2141.02 (I) states, "In determining the differences between the prior art and the claims, the question under 35 U.S.C. § 103 is not whether the differences themselves would have been obvious, but whether the claimed invention as a whole would have been obvious." [See, MPEP § 2141.02(I); original emphasis]. MPEP § 2106 (II)(C), states *inter alia*: "USPTO personnel may not dissect a claimed invention into discrete elements and then evaluate the elements in isolation. Instead, the claim as a whole must be considered." Applicants submit that the pending rejection asserts over-generalizations that conclude obviousness of the alleged differences in isolation and not in respect to the claim elements recited in each claim taken as a whole. For example, the rejection alleges that, "It would have been obvious to one of ordinary skill in the art at the time the invention was made to use the usage data and the program sponsor 'finder fee' ... to develop a financial hedging strategy to help prevent foreseeable losses..." (p. 11, ¶ 1). Applicants submit that the pending rejection has repeated such isolated assertions of baseless obviousness throughout.

Applicants submit that the pending rejection is based on impermissible hindsight in repeatedly relying on conclusory assertions of obviousness without discussing how the cited references are allegedly modifiable to achieve the claimed subject matter as required by the MPEP. Applicants request clarification of the rejections beyond conclusory statements including providing an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made. For example, the pending rejection does not provide a single reference citation or invocation of Official notice with respect to any of the dependent claims. Accordingly, Applicants respectfully request withdrawal of this basis for rejection. Should the Examiner disagree, Applicants respectfully request clarification and

specific citations/evidence in the cited art supporting the alleged obviousness of claim limitations in respect to the various claims as wholes, as required by the MPEP.

II. The pending claims are patentably distinct from the cited references

MPEP § 2142 provides that, "If the examiner does not produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness." Applicants contend that a *prima facie* case of obviousness has not been established for at least the reasons given above. Nevertheless, Applicants have amended claims 31, 55, and 115 and provided the following discussion in an effort to provide clarification of the claim elements, expedite further prosecution, and to more accurately track Applicants' current practices. Applicants maintain that the claims in their original form are not anticipated or rendered obvious by the cited references taken alone or in combination and reserve the right to return to that form and argue patentability at a later time.

The limitation of "receiving program sponsor data, wherein said program sponsor data includes an amount of a finder's fee paid by a program sponsor to a program operator on establishment of an affinity relationship between the program sponsor and the customer" in claim 115 is not disclosed in any of the references alone or in combination with each other. McCall discloses only an intermittent customer rewards system that "will track the customer purchases and compare them with a predefined criteria to determine when a fuel discount is to be provided. When a customer meets one of the predefined criteria, the reward system will authorize a fuel discount and provide the customer with a mechanism to obtain the fuel at a discounted unit price" (McCall, Abstract).

The reward system of McCall determines a one-time per-unit discount, with no relation to price, provided to a customer based on the customer's prior purchasing behavior meeting certain criteria, such as exceeding "a quantity threshold, a dollar value threshold, made purchases made on specific dates, or the like" (McCall, column 2, lines 34-36). The reward system in McCall merely "adjusts the purchase price by subtracting the discount amount and allows the fuel to be dispensed at that rate for this transaction only" (McCall, column 2, lines 52-55); i.e., the purchase price in McCall is not guaranteed, rather, it is just the pump price at the time of purchase. Therefore, McCall does not disclose "program sponsor data includes an amount of a finder's fee paid by a program sponsor to a program operator on establishment of an affinity relationship between the program sponsor and the customer." For at least these reasons, claim 115 is allowable.

Claims 31 and 55 have been amended to recite, "calculating by a processor a customer-specific, fixed, guaranteed program price a customer is authorized to pay for any qualified fuel purchase from any qualified fuel seller," and, "a number of months during which the customer is authorized to buy fuel at the customer-specific, fixed, guaranteed program price." This contrasts the discount system discussed in McCall, where the price is neither fixed nor customer-specific. Instead, McCall discusses a discount from the retail pump price, which varies with time and with retail location, that may be based on fluctuations in the price of oil and/or gasoline. Whereas in amended claims 31 and 55, the "customer is authorized to pay" a "customer-specific, fixed, guaranteed program price ... for any qualified fuel purchase from any qualified fuel seller" which is clearly not disclosed in McCall. Claims 31 and 55 are allowable for at least these reasons.

Further, claims 31, 55, and 115 recite the limitation of using "customer expected fuel usage dataset and said finder's fee amount of said program sponsor data" to "develop a financial hedging strategy to diminish a risk to the program operator in connection with guaranteeing of the customer-specific, guaranteed program price in light of volatility of fuel prices," which is not disclosed in the cited references alone or in combination with each other. The Office Action on page 9 has cited McCall, however, the cited portion states "that this data can be then analyzed to determine the success of the discount program. That is, the predefined purchase criteria can be adjusted as needed to provide the discount for different items..." (Col. 10, Lines 3-6).

This merely explains that "the predefined purchase criteria can be adjusted" however, the independent claims, contrary to this, recites a "**guaranteeing of the customer-specific, guaranteed program price** in light of volatility of fuel prices." (Emphasis added). McCall teaches away from the guaranteed program price because it allows the predefined purchase criteria to be adjusted instead of being a guaranteed program price.

Further, the Examiner has cited Infinity to cure the deficiencies in McCall. (August 19, 2008 Office Action, p. 7). However, Infinity, alone or in combination with the other references, does not disclose using "**said finder's fee amount of said program sponsor data** to develop a financial hedging strategy to **diminish a risk to the program operator** in connection with guaranteeing of the customer-specific..." (Emphasis added). The Office Action states that Infinity "discloses that with respect to heating oil for homes, it is known to provide customers with guaranteed fixed program prices for their 'annual consumption of fuel.'" Infinity at best defines general options contracts or Exchange futures for fuel, and is devoid of any concepts of

"guaranteeing of the customer-specific, guaranteed program price in light of volatility of fuel prices."

The most relevant part of Infinity merely states that "[t]he fuel oil dealer hedges these guaranteed price agreements by purchasing Exchange futures or options contracts, or by purchasing a wholesale supply deal which ties terminal cash prices to Exchange future prices." Infinity, alone or in combination with the other references, does not disclose using **"said finder's fee amount of said program sponsor data** to develop a financial hedging strategy to **diminish a risk to the program operator** in connection with guaranteeing of the customer-specific" as recited. (Emphasis added). Therefore, it is not obvious to one of ordinary skill in the art to combine Infinity with McCall, particularly since McCall teaches away from "guaranteeing of the customer-specific, guaranteed program price in light of volatility of fuel prices." However, even if McCall and Infinity were combined, the combination would not disclose the instant claimed invention. For at least these reasons claims 31, 55, and 115 are allowable.

The Examiner also cites Weather Futures to cure the deficiencies in McCall. Counter to the Examiner's assertions, the limitations of using **"said finder's fee amount of said program sponsor data to develop a financial hedging strategy** to diminish a risk to the program operator **in connection with guaranteeing of the customer-specific, guaranteed program price** in light of volatility of fuel prices" are not disclosed in Weather Futures. (Emphasis added). Instead, Weather Futures simply discusses hedging home fuel based future weather, as noted by the Examiner, "the article discloses that a natural gas company can 'hedge' itself against lost revenues if a warm winter cuts sales" (August 19, 2008 Office Action, p. 11).

However, the Examiner asserts that "it would have been obvious to one of ordinary skill in the art at the time the invention was made to use the usage data deemed as

necessary or relevant data, to develop a financial hedging strategy to help prevent foreseeable losses due to changing demand and fuel prices" (August 19, 2008 Office Action, p. 11). Applicant respectfully disagrees. As discussed above, the rewards system of McCall makes no mention of risk and is independent of the price of gas, thus having no need or use for hedging generally, let alone the weather derivatives discussed in Weather Futures.

Thus, it is respectfully submitted that since McCall and Weather Futures are missing the claimed limitations of developing financial hedging strategies using a "finder's fee amount of said program sponsor data to develop a financial hedging strategy to diminish a risk to the program operator in connection with guaranteeing of the customer-specific, guaranteed program price," as recited, for example, in claims 31, 55, and 115." And the combination of said references similarly does not result in nor do they anticipate claim 31, 55, and 115 for at least the same reason. Therefore independent claims 31, 55, and 115 are in condition of immediate allowance for this additional reason.

Applicants submit that, inasmuch as claims 38-41, 61, and 65-68 directly or indirectly depend from independent claims 31 and 55, they are patentably distinct over the applied references for at least the reasons given above. Accordingly, Applicants respectfully request withdrawal of rejections of these claims.

CONCLUSION

Consequently, the references cited by the Office Action do not result in the claim elements, there was/is no reason, rationale or motivation (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)) for such a combination of references, and the claimed inventions are not admitted to be prior art. Thus, the Applicant respectfully submits that

the supporting remarks and claimed inventions, claims 31, 38-41, 55, 61, 65-68 and 115 overcome all rejections and/or objections as noted in the Office Action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicant believes that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements were not discussed here or in previous amendments/responses, Applicant asserts that all such remaining and not discussed claim elements, all, also are distinguished over the prior art and reserves the opportunity to more particularly remark and distinguish such remaining claim elements at a later time should it become necessary. Further, any remarks that were made in response to an Examiner objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Examiner objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not concede that any claim elements have been anticipated and/or rendered obvious by any of the cited reference(s). Accordingly, Applicant respectfully requests allowance, and the reconsideration and withdrawal of the rejection(s) and/or objection(s).

If a telephone conference would facilitate prosecution of this application in any way, the Examiner is invited to contact the undersigned at the number provided.

AUTHORIZATION

The Commissioner is hereby authorized to charge any additional fees which may be required for consideration of this Amendment to Deposit Account No. 03-1240, Order No. 17209-075.

In the event that an extension of time is required, or which may be required in addition to that requested in a petition for an extension of time, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely and is hereby authorized to charge any fee for such an extension of time or credit any overpayment for an extension of time to Deposit Account No. 03-1240, Order No. 17209-075

Respectfully submitted,
CHADBOURNE & PARKE, L.L.P.

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